

### **Remarks**

Reconsideration of the above-identified application is respectfully requested. Claims 1-40 are pending in this application.

In the Office Action mailed September 26, 2003, the Examiner rejected claims 1-8, 11-18, 21-28 and 31-40 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,516,342 to Feldman et al. ("the '342 patent"). The Examiner also rejected claims 9, 10, 19, 20, 29 and 30 under 35 U.S.C. §103(a) as unpatentable over the '342 patent.

For the reasons set forth in detail below, the Applicant respectfully traverses the Examiners rejections of the claims.

#### **Rejection of Claims 1-8, 11-18, 21-28 and 31-40 Under 35 U.S.C. §102(e)**

As noted above, in the September 26, 2003 Office Action, the Examiner rejected claims 1-8, 11-18, 21-28 and 31-40 under 35 U.S.C. §102(e) as anticipated by the '342 patent. The Applicant believes, however, that those claims are not anticipated by that reference.

The Applicant's claimed invention is directed to a system and method for remotely configuring data storage space. As set forth in independent claims 1, 11, 21, 31 and 36, a plurality of storage devices have storage space comprising free storage space and allocated storage space. The allocated storage space is to be allocated substantially permanently to a remote user for storing user data. A portion of the free storage space may be automatically transferred to the allocated storage space, or a portion of the allocated storage space can be automatically transferred to the free storage space in response to user requests to increase or decrease the size of the allocated storage space. In that regard, claims 1, 11, 21, 31 and 36 have been amended to more particularly reflect the Applicant's invention. Support for those amendments, which do not change or affect the scope of those claims, can be found in the Specification, for example on page 6, line 12 through page 8, line 18.

The '342 patent is directed to a method and apparatus for extending memory using a memory server. The memory server provides additional memory to a network connected computer, which may be referred to as a network client, when the network client's local memory is insufficient for a particular application. As a result, applications that could not be executed in a memory constrained environment, such as the network client, can be executed using the memory server. (*See, e.g.*, The '342 Patent, col. 2, ll. 45-62.)

According to the '342 patent, interaction with the memory server begins only when the memory requirements of an application exceed that of the network client's local memory. In addition, interaction with the memory server ends when the memory requirements of the application are reduced to within the limits of the network client's local memory. (*See, e.g.*, The '342 Patent, col. 4, ll. 26-38.) As is readily apparent, then, the memory server of the '342 patent has additional memory that is simply allotted to a network client temporarily for use in a particular application.

Thus, in contrast to the Applicant's claimed invention, the '342 patent fails to teach or suggest allocated storage space to be allocated to a remote user substantially permanently for storing user data. The '342 patent also fails to teach or suggest automatically transferring a portion of free storage space to such allocated storage space, or automatically transferring a portion of such allocated storage space to free storage space in response to user requests to increase or decrease the size of such allocated storage space.

The Applicant therefore believes that independent claims 1, 11, 21, 31 and 36 are not anticipated by the '342 patent. Accordingly, reconsideration of the Examiner's rejection thereof under 35 U.S.C. §102(e) is respectfully requested.

Claims 2-8, 12-18, 22-28, 32-35 and 37-40 depend either directly or indirectly from independent claims 1, 11, 21, 31 and 36, respectively, and include all the limitations thereof. As a result, and for the reasons set forth above concerning claims 1, 11, 21, 31 and 36, the Applicant believes that claims 2-8, 12-18, 22-28, 32-35 and 37-40 likewise overcome

the Examiner's rejection thereof under 35 U.S.C. §102(e), and reconsideration of that rejection is also respectfully requested.

**Rejection of Claims 9, 10, 19, 20,  
29 and 30 Under 35 U.S.C. §103(a)**

As also noted above, in the September 26, 2003 Office Action, the Examiner also rejected claims 9, 10, 19, 20, 29 and 30 Under 35 U.S.C. §103(a) as unpatentable over the '342 patent. The Applicant believes, however, that those claims are not rendered obvious by that reference.

More specifically, as demonstrated above, the '342 patent fails to anticipate independent claims 1, 11, 21. Claims 9, 10, 19, 20, 29 and 30 depend either directly or indirectly from independent claims 1, 11 and 21, respectively, and include all the limitations thereof. As a result, and for the reasons set forth above concerning claims 1, 11 and 21, the claims 9, 10, 19, 20, 29 and 30 are not rendered obvious by the '342 patent.

Accordingly, reconsideration of the Examiner's rejection of claims 9, 10, 19, 20, 29 and 30 is respectfully requested.

### **Conclusion**

For the foregoing reasons, the Applicants believe that claims 1-40 meet both the formal and substantive requirements for patentability, and that the application is in condition for allowance. Accordingly, such action by the Examiner is respectfully requested.

If a telephone conference would expedite allowance or resolve any additional questions, such a call is invited at the Examiner's convenience.

Respectfully submitted,

**Thomas P. Fowler**

By Jeffrey M. Szuma  
Jeffrey M. Szuma  
Reg. No. 35,700  
Attorney/Agent for Applicant

Date: December 10, 2003

**BROOKS KUSHMAN P.C.**  
1000 Town Center, 22nd Floor  
Southfield, MI 48075  
Phone: 248-358-4400  
Fax: 248-358-3351